

REMARKS

The present invention is attempting to optimize the performance of a magnetophoretic display panel. One of the popular uses of such a device is as a small child's toy that permits the child to draw images on the display panel by the application of a magnetic force. Attempts have been made to provide improved characteristics for such a device, for example, by providing a multi-colored display as recognized in the cited *Yamazaki* U.S. Patent No. 6,196,848 so that a line trace made across a display can realize different colors in different regions of the display.

The present invention is attempting to improve the resolution and performance of a magnetophoretic display panel while working within the economic limits imposed by the competitive marketplace. In this regard, both the structure and the magnetic recording member and its interaction with a viscous fluid that has been colored to obscure the colored magnetic particles have been addressed in our present claims.

The Office Action contended that the *Yamazaki* reference rendered obvious claims 1-30 of our application. However, the Office Action acknowledged that the *Yamazaki* reference did not teach the specific interior space thickness nor a magnetic recording member having a particular effective range of magnetic flux density.

Applicants respectfully traverse the application of the *Yamazaki* reference as in fact providing a teaching reference to a person of ordinary skill in this field to choose particular materials, ranges and elements as set forth in our present claim structure.

As noted in the case of *In-re Rijckaert*, 28 USPQ2d 1955 (CAFC 1993):

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1143, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the

burden of coming forward with evidence or argument shift to the applicant. *Id.* "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested that claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) quoting *In re Reinhart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned.

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Rijckaert argues that the examiner has not established a *prima facie* case of obviousness and that the examiner's assumptions do not constitute the disclosure of prior art. We agree.

The Office Action misconstrues the actual teaching of the *Yamazaki* reference and accordingly has improperly contended that it would teach the features of the present invention. For example, on Page 3 of the Office Action, *Yamazaki* was contended to inherently teach "said colored liquids comprises titanium oxide, silicon oxide", (see Column 5, lines 20-28). Actually, Column 5, lines 20-28 is a chart disclosing the composition of a stainless steel magnetic particle. There is no teaching at all with regards to any composition of a colored liquid. After reviewing the entire specification, it is found that a colored liquid is simply described on Column 4, lines 54-55 as follows:

"...a coloring agent constituting a background, as well as a thickening agent added as desired."

This disclosure certainly does not teach nor suggest the components of the present invention at all.

As can be appreciated, there have been numerous attempts to provide improvements in this field particularly to increase the image resolution and performance of toys for such small children. Since this is a relatively crowded field, the improvements submitted and set forth in our specification and claims must be considered in view of this fact.

Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.

Continental Can Co. USA Inc. v. Monsanto Co.,
20 USPQ 2d 1746, 1752 (Fed Cir. 1991).

Since the *Yamazaki* reference is not teaching the features set forth in our present invention, it is instructive to review what the *Yamazaki* reference is attempting to do. In this regard, it wants to use “odd configuration” or “odd shapes” for the physical configurations of the magnetic particles. See Column 5, line 31-40. Additionally, it is recognized in the Column 5, line 31-40, that the *Yamazaki* disclosure is using stainless steel for the magnetic particles and as a result there is a reduction in the saturation magnetization by about 10% which requires increasing the magnetic force of the magnetic pen by about 20%. See Column 6, lines 27-32.

The *Yamazaki* reference accordingly suggests a significantly higher magnetic force be utilized and it is respectfully submitted that the Office Action’s contention that simply optimizing the magnetic flux density would be obvious from the *Yamazaki* system is erroneous. As noted in our presently pending claims, such as Claim 9 amended, our magnetic particles are of a magnetite material and of a spherical configuration with an average particle diameter of 100 μm . *Yamazaki* utilizes stainless steel magnetic particles of an odd shape configuration with an average particle size of 70-75 μm . This particle size is not the diameter, but rather is a measurement along a major axis thereof. See Column 5, lines 37-41.

Thus, the Office Action does not correctly interpret the actual teaching in the *Yamazaki* reference although it does acknowledge that the *Yamazaki* reference does not teach any of the specific ranges, percentages nor magnetizations defined in our claims.

The Office Action attempts to cite the case of *In re Rose* 105 USPQ 237 (CCPA 1955)

and *In re Reven* 156 USPQ 679 (CCPA 1968) for justification of the rejection. Copies of these cases are attached hereto for reference purposes.

The *In re Reven* case stands for the premise that discovering particular ranges within a range disclosed by the prior art would be within the skill of a person in the art unless there is evidence of record and specific language in the claims that would show the patentable significance. The *Yamazaki* reference does not suggest nor teach any ranges relevant to the present claims let alone a broader range that would encompass our specific limitations in our claims.

The *In re Rose* case was directed to bundling strips of lumber of different lengths. The applicant had argued a difference in the size to permit the packages to be handled by a lift truck distinguished over the cited references that could be moved by hand. The *In re Rose* decision stands for the premise that a mere change in size of an article does not necessarily establish an invention. It should be noted that the cited references actually disclose the same structural features and the argument was based simply on size without stating any criticality to the particular size. Neither of these cases stand for the premise that it is acceptable to improperly construe a reference nor to further find that a reference, that doesn't teach any ranges or specific perimeters, can still be contended to be a teaching to a person of ordinary skill in the field.

The importance of our particular claim features can be supported within our specification. For example, the dimensions of our magnetic panel and its relationship with not only the viscosity but the effective magnetic flux density can be seen starting, for example, on Page 8, line 7 through Page 9, line 10. Thus, a thickness of the magnetic panel, the viscosity and the effective magnetic flux densities are carefully balanced to achieve the purposes of our present invention.

As further noted on Page 10, line 14 through Page 11, line 33, we have carefully controlled the viscosity so that our colored liquid is within a range of 200 cP to 800 cP and have explained the significance of the limits of our range. We have used magnetic particles of a ferrite powder having a particular spherical diameter and have balanced the weight of the particles within the display relative to the colored liquid. These features are defined in certain independent and dependent claims and are neither addressed nor taught in the *Yamazaki* reference.

In summary, we can find no support in the cited cases attached hereto to justify the interpretation of the *Yamazaki* reference against our presently pending claims.

It is believed that the case is now in condition for allowance and an early notification of the same is requested. If there are any questions with regard to this matter, the undersigned attorney would appreciate a telephone conference.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on May 3, 2005.

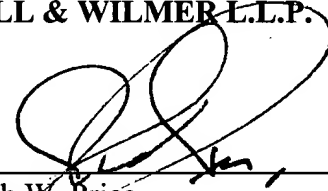
By: Sharon Farnus


Signature

Dated: May 3, 2005

Very truly yours,

SNELL & WILMER L.L.P.



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